

REMARKS

Claims 2-22, 25, 26, 29 and now new claims 30-36 are pending in this application. None have been allowed. Claims 1-10, 18-22, 26 and 26 stand rejected. Claims 11-17 and 29 are objected to.

At the middle of page 2 of the Action, the Examiner rejected claims 1, 22, 25, and 26 as anticipated by WO 02/094823. The Examiner states:

Claims 1, 22, 25, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 02/094823. a compound of formula I is anticipated by the compounds of examples 1,2,4,6,9 of table 1, p. 45 of '823.

Claims 1, 2, 22, 25, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by '823 (ibid.). A compound of formula I is anticipated by the compound of examples 24 and 61 of table 2, p. 46 of '823.

Applicants respectfully disagree with the Examiner's analysis.

Applicants respectfully direct the Examiner's attention to the fact that each choice of definition "Y" of claim 1 includes an -COOR₄ group, wherein R₄ can be H or -C₁₋₆alkyl. On the other hand in the remaining compound claims there is no choice equivalent to R₄ = -C₁₋₆alkyl.

None of Examples 1, 2, 4, 6 or 9 of reference WO 02/094823 possesses this definitionn. See Table 1 at page 45 of the reference. On the other hand, Example 24 and 61 do possess a group within this definition. Note further that WO 02/094823 and US 6,677,351 are related and that in both documents R₂ can be -C(O)-O-C₁₋₆alkyl.

In order to advance the prosecution of this case, applicants have cancelled claim 1. Applicants reserve the right to pursue the cancelled subject matter in a continuing, division or counterpart application. One such application is USSN 10/534,582. Applicants respectfully submit that their cancellation of claim 1 renders this issue moot.

At the middle of page 3 of the Action, the Examiner rejected claim 1 on the ground of obviousness type double patenting over claim1 of 6,677,351. Applicants respectfully submit that their cancellation of claim 1 renders this issue moot.

At page 4 of the Action, the Examiner rejects claims 25 and 26 as failing to comply with the enablement requirement. The Examiner states:

Claims 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which pertains, or

with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully traverse. The core of the Examiner's argument appears to be that "While PDE-IV inhibitors have been identified as a potential therapeutic target in a number of diseases, there is no known compound effective in treating all of the disorders listed in claim 25". Applicants respectfully submit that this argument is flawed.

The fact that no inhibitor of PDE4 has been shown to be effective in treating all of the disorders listed in claim 25, do not mean that the compounds lack utility or that the claim fails to meet 35 USC 112. For example, under *Cross v Iizuka*, 224 USPQ 739 (CAFC 1985), in vitro testing can be sufficient to satisfy the utility requirement. In that regard, applicants direct the Examiner's attention to the background of the invention and to the assays disclosed at pages 23 to 25 of the application. Given that applicants have satisfied the utility requirement, applicants respectfully submit that the disclosure at pages 19 to 23 satisfies 35 USC 112. To further support applicant's position, applicants hereby submit additional references discussing the links between inhibition of PDE4 and the treatment of a number of conditions listed in claim 25. Note that one reference focuses on memory. Other indications are discussed in Houslay, et al. (2005), of record. Still others are discussed in the background of the invention.


The above arguments notwithstanding, applicants have added additional methods claims in order to advance the prosecution of this application.

At page 7 of the Office Action, the Examiner indicated that Claims 11-17 and 29 are objected to as being dependent on a rejected base Claim. Applicants respectfully traverse. As mentioned above, in claim 1 each choice of definition "Y" of claim 1 includes an -COOR⁴ group, wherein R4 can be H or -C₁₋₆alkyl. However, the other composition of matter claims, claim only the acid. In that respect, applicants respectfully traverse. On the other hand, claims 21, 22, 25 and 26 depended from claim 1. These claims have been amended to depend from claim 2. Applicants respectfully submit that this change in dependency does not present new matter. Support is found in the original claims.

Finally, applicants have added new claims 30 to 36. Applicants respectfully submit that these claims add no new matter. For example, claim 30 is Example 12, at page 59. With regard to claims 31 to 36 support is found throughout the application and in the original claims.

Having addresses all of the outstanding objections and rejection, applicants respectfully submit that the application is now in condition for allowance, and passage thereto is earnestly requested. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of this case.

Respectfully submitted,

By 
Curtis C. Panzer
Reg. No. 33,752
Attorney for Applicant

Date: April 5, 2006

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(908) 594-3199